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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,722	03/28/2002	Ralf-Peter Franke	CERA-233	7010

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EXAMINER
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DAVIS, DANIEL J

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 07/16/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,722

Applicant(s)

FRANKE ET AL.

Examiner

D Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Pre-amendment 3/28/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The specification is objected to for the following reasons:

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

A "Brief Description of the Drawings" is missing from the specification.

Proper headings such as, "Background of the Invention," are required to distinguish the various sections of the application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 30, 32, 33, 35-38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Leins et al. (US 5,641,251). Leins disclose a drill bit in Fig. 1 comprised entirely of an aluminum oxide ceramic (Col. 2, lines 26-28). The ceramic is a

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bioinert biocompatible, high strength ceramic. Although they do not disclose the drill bit as a "surgical instrument," it may be used as such.

Claims 30, 32, 34, 36, 37, 39 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Abouaf et al. (US 5,871,547). Abouaf disclose a hip joint prosthetic having a head comprising YTZP (Col. 4, lines 29--et seq.). The prosthetic is considered a surgical instrument or tool because it is used to connect the hip. The device is made of a bioinert biocompatible, high strength ceramic. Col. 4, lines 56-57 describe the surface "consisting essentially of 100% tetragonal zirconia," or YTZP.

Claims 30-33, 35-38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Hood. Hood discloses an ultrasonic surgical knife (Col. 1, lines 14-28) having teeth comprising a metal base with an aluminum oxide ceramic coating (Col. 7, lines 30-55). Since the device has teeth, it is also considered a saw. Since they are silent regarding any impurities contained in the ceramic coat, the coat "*consists* of the biocompatible bioinert material."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(c) which forms the basis for all obviousness rejections set forth in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Claims 30, 32, 34-37 and 39-41 are rejected under 35 U.S.C. 103(c) as being unpatentable over Leins et al. in view of Abouaf et al. Leins disclose a drill bit, capable of being used in the body, comprised entirely of a high-strength technical ceramic. However, they are silent regarding the use of another high-strength technical ceramic, particularly YTZP. Nevertheless, Abouaf teach the use of YTZP in a prosthesis because of its durable, wear resistant nature. Leins require a durable and wear resistant material for their drill bit. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use YTZP ceramic in the Leins drill bit as taught by Abouaf because it is durable and wear resistant.

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**Conclusion**


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newkirk et al. (US 5,073,527), Newkirk et al. (US 5,306,677), tucker (US 5,718,682), Eggers (US 5,776,128), Pugliesi et al. (US 5,801,110), and Slater (US 6,447,511).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

DJD  
July 11, 2003

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700